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This Opinion is Not Citable as Precedent of the TTAB

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Dryvit Systems, Inc.

Serial No. 76378373

Elliott A. Salter of Salter & Michaelson for Dryvit
Systems, Inc.

Jill Alt, Trademark Examining Attorney, Law Office 114 (K.
Margaret Lee, Managing Attorney).¹

Before Quinn, Holtzman and Rogers,
Administrative Trademark Judges.

Opinion by Rogers, Administrative Trademark Judge:

Dryvit Systems, Inc. [applicant] has applied to
register INTERMEDIATE MESH in standard character form on
the Principal Register as a mark for "fiberglass mesh used
in the formulation of exterior building wall surfaces."
The application was filed based on applicant's claim of
first use of the mark, and first use of the mark in

¹ A different examining attorney issued the initial office action
refusing registration.

commerce, on January 11, 1989. Moreover, the record is clear that applicant claims continuous use since its date of first use.

By the initial office action regarding the instant application, the examining attorney refused registration of INTERMEDIATE MESH on the ground that it is merely descriptive of applicant's identified goods. See Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1). In addition, the examining attorney raised the possibility that the proposed mark might even have to be refused as generic.

In response to the office action, applicant explained that it had previously obtained a registration, on the Principal Register, for INTERMEDIATE MESH for precisely the same goods. That registration, however, was cancelled under Sections 8 and 9 of the Trademark Act, 15 U.S.C. §§ 1058 and 1059, when applicant failed to file the required affidavit of use and request for renewal.²

Notwithstanding applicant's reference to its prior registration, the examining attorney made the refusal of registration under Section 2(e)(1) final. In that final

² Registration no. 1590895 issued April 10, 1990 and included a disclaimer of exclusive rights in MESH. It was cancelled April 28, 2001.

refusal, the examining attorney explained that the proposed mark had, in the time since the prior registration issued, become a very descriptive term in the industry and might even be generic. Accordingly, the examining attorney attempted to dissuade applicant from responding to the final refusal by seeking registration on a claim under Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f), that the proposed mark has acquired distinctiveness, or by seeking registration on the Supplemental Register.

Subsequently, applicant filed a notice of appeal, and shortly thereafter, its appeal brief. A Board paralegal, noting that applicant had argued in its appeal brief for either registration on the Principal Register or for remand to the examining attorney for consideration of a claim of acquired distinctiveness under Section 2(f), allowed applicant time to request remand and present its case, in the alternative, for registration under Section 2(f). Applicant did just that, but the examining attorney maintained the refusal of registration under Section 2(e)(1) [the "continuation" refusal] and found applicant's evidence of acquired distinctiveness insufficient under Section 2(f).

By response to the continuation refusal, applicant presented additional arguments in support of registration

under Section 2(f), asserting that "its INTERMEDIATE MESH mark acquired distinctiveness and became proprietary before usage of the mark by others in the field, and that applicant never abandoned its rights, nor did it do anything or fail to do anything that would support a position that the mark has become generic, except for its inadvertent failure to renew Reg. #1,590,895." Also, in its brief, applicant argues that it "has successfully policed its DETAIL MESH and ULTRAMESH marks and would have done the same with respect to INTERMEDIATE MESH but for the fact that the infringing activities did not come to Applicant's attention until after its original registration for INTERMEDIATE MESH had inadvertently lapsed."

In the next (second) office action following remand, the examining attorney essentially withdrew the earlier final refusal under Section 2(e)(1) on grounds of descriptiveness, and withdrew the continuation refusal insofar as it continued that ground for the final refusal. Then the examining attorney explained that the proposed mark was being refused under Section 2(e)(1) on the ground that it is generic and incapable of functioning as a mark; and that no amount of evidence of acquired distinctiveness would overcome the refusal. This action was stated to be final as to that ground.

This appeal was subsequently resumed and applicant filed a supplemental brief. The examining attorney then filed a brief. Applicant did not request an oral hearing.

In its supplemental brief, applicant argues that INTERMEDIATE MESH is not generic, but concedes that it is descriptive and not inherently distinctive. Applicant also argues that the proposed mark is capable of acquiring distinctiveness and that "is precisely what has happened." The examining attorney, in contrast, is essentially arguing that the proposed mark is generic or so highly descriptive as to be incapable of distinguishing applicant's goods from those of others; and she asserts that no amount of evidence of acquired distinctiveness would suffice to allow registration on the Principal Register. As a result, this appeal no longer presents the issue earlier argued by applicant, i.e., whether the proposed mark is suggestive but not merely descriptive.

When a proposed mark is refused registration as generic, the examining attorney has the burden of proving genericness by "clear evidence" thereof. See In re Merrill Lynch, Pierce, Fenner & Smith, Inc., 828 F.2d 1567, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987); see also In re Gould Paper Corp., 834 F.2d 1017, 5 USPQ2d 1110, 1111 (Fed. Cir. 1987). The critical issue is to determine whether the

record shows that members of the relevant public primarily use or understand the term sought to be registered to refer to the category or class of goods or services in question. H. Marvin Ginn Corp. v. International Ass'n of Fire Chiefs, Inc., 782 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986); In re Women's Publishing Co. Inc., 23 USPQ2d 1876, 1877 (TTAB 1992). Making this determination "involves a two-step inquiry: First, what is the genus of goods or services at issue? Second, is the term sought to be registered ... understood by the relevant public primarily to refer to that genus of goods or services?" *Ginn, supra*, 228 USPQ at 530. Evidence of the public's understanding of a term may be obtained from any competent source, including testimony, surveys, dictionaries, trade journals, newspapers and other publications. See *Merrill Lynch, supra*, 4 USPQ2d at 1143 (Fed. Cir. 1987), and In re Northland Aluminum Products, Inc., 777 F.2d 1556, 227 USPQ 961, 963 (Fed. Cir. 1985).

In its original appeal brief, applicant did not discuss the class of goods or services at issue in this case because the refusal at that point was on the grounds of descriptiveness. In its supplemental brief, applicant does not directly discuss the class of goods or services but does say that MESH "is a noun that denotes a product category" but that the term INTERMEDIATE is an adjective

that identifies a characteristic of the generic term MESH. The examining attorney, while acknowledging the distinction drawn by applicant, states that the "genus is clearly 'MESH,'" but disagrees with applicant's conclusion that only the noun MESH could be viewed as generic. In this case, we find the identification of goods to be an appropriate specification of the class of goods or services. "Mesh" alone would be too broad a specification of the class because, as shown by the record, there are too many different types of mesh, with many different applications. Thus the class of goods is "fiberglass mesh used in the formulation of exterior building wall surfaces."

To determine what the record reveals about the relevant public's understanding of INTERMEDIATE MESH requires us first to define the relevant public. In this case, given that the class of goods appears to be an item used in construction of buildings, the relevant public would include such individuals as builders, architects, and officials concerned with the compliance of buildings with construction codes.

The record in this case includes dictionary definitions of INTERMEDIATE ("lying or occurring between two extremes or in a middle position or state") and "MESH"

("an openwork fabric or structure; a net or network").

Thus, the examining attorney asserts INTERMEDIATE MESH, when considered in conjunction with the class of goods, would be understood by the relevant public as meaning "a middling strong type of reinforcing construction mesh."

Apart from the dictionary definitions, the examining attorney has submitted a copy of an Internet web page product description from STUC-O-FLEX International, Inc. (www.stucoflex.com/interfiberglassmesh.html) which reads "Intermediate mesh = 11 oz. Per yard. Reinforcing mesh used to provide impact resistance for EIFS systems where a higher than normal impact resistance is required. This can be used as a substitute for standard mesh." Also submitted for the record was a reprint of an article in the January 1999 issue of Building Design & Construction, with the headline "Product focus: eifs; exterior insulation and finish systems," and which includes brief discussions of various products from "EIFS manufacturers." One discussion refers to a system used by Architect Arrowstreet Inc. of Somerville, Mass.: "This system uses a thicker flexible base coat, a layer of 10-oz. intermediate mesh and Owens Corning's 'Foamular' extruded polystyrene board -- all of which combine to produce a durable, cost-effective cladding that is highly impact- and water-resistant."

A reprint of web pages covering fiberglass reinforcement mesh for use with EIFS construction, from Hanover Wire (www.hanoverwire.com/reinf.htm), lists four different styles of mesh, including Standard Mesh, Intermediate Mesh, Hi-Impact Mesh and Impact Mesh. A technical data sheet on *ExcelPlus* Reinforcing Mesh (www.excelmg.com) describes the attributes of Standard Mesh, Extra Standard Mesh, Detail Mesh, Intermediate Mesh, High Impact Mesh, Ultra Impact Mesh, and Corner Mesh. A Sto Corp. web page (www.stocorp.com) lists Sto Mesh, Sto Detail Mesh, Sto 6 oz. Mesh, and Sto Intermediate Mesh. Copies of web pages from applicant (www.dryvit.com) display two pages of what appear to be a four-page list of Dryvit MSDS sheets (the first page and the page listing applicant's meshes); and applicant lists Reinforcing Mesh as including, among others, Standard Mesh, Intermediate Mesh, and Corner Mesh. The CCX Fiberglass web pages of record (www.ccxfiberglass.com/eifs.htm) list six styles of mesh: Standard, Intermediate, Ultra, Standard Plus, Hi-Impact and Impact. And there is information of record about various other producers of mesh, each of which produces various styles or grades of mesh and each of which includes in its list an Intermediate mesh. Virtually all of the producers list their products as for use in EIFS

construction, meaning that any architects considering use of such construction techniques, or builders employing EIFS construction techniques, would expect to be able to call for or order an Intermediate mesh from any one of a number of producers and would call for or order the product by such name.

On this record, we have no doubt that "Intermediate mesh" is a generic term for a type of mesh utilized in EIFS construction. We are not persuaded otherwise by applicant's argument in its supplemental brief that "'MESH', which is a noun that denotes a product category, is per se generic but has been disclaimed.³ The term 'INTERMEDIATE', on the other hand, is an adjective which identifies a characteristic of the generic term 'MESH', and hence at most is descriptive but not generic."

As the examining attorney has noted in her brief, an adjective can be generic and there are many cases in which two-word terms including an adjective have been found generic. See, e.g., Filipino Yellow Pages Inc. v. Asian Journal Publications Inc., 198 F.3d 1143, 53 USPQ2d 1001

³ In fact, while there was a disclaimer of "mesh" in applicant's now cancelled registration, the current application does not include such a disclaimer. However, because applicant concedes that INTERMEDIATE MESH is descriptive and MESH is generic, should applicant eventually succeed in its attempt to obtain registration of the composite under Section 2(f), it should nonetheless enter the disclaimer of the generic term MESH.

(9th Cir. 1999) (FILIPINO YELLOW PAGES generic for telephone directory directed primarily to Filipino-American community); Genesee Brewing Co. v. Stroh Brewing Co., 124 F.3d 137, 43 USPQ2d 1734 (2d Cir. 1997) (HONEY BROWN is generic when used for a brown ale made with honey); Blinded Veterans Ass'n v. Blinded American Veterans Found., 872 F.2d 1035, 10 USPQ2d 1432 (D.C. Cir. 1989) (BLINDED VETERANS found generic for once-sighted persons who served in the armed forces); A.J. Canfield Co. v. Honickman, et al., 808 F.2d 291, 1 USPQ2d 1364 (3d Cir. 1986) (CHOCOLATE FUDGE generic for diet sodas tasting like chocolate fudge); Conference of Bar Examiners v. Multistate Legal Studies, 692 F.2d 478, 216 USPQ 279 (7th Cir. 1982) (MULTISTATE BAR EXAMINATION held a common descriptive term and "the most appropriate way of describing a test prepared for determining the competency of applicants to the bars of the several states.").

Equally unpersuasive is applicant's argument that the evidence of use of "Intermediate mesh" by others, made of record by the examining attorney, should be discounted. Applicant argues that its use of the term was "upon information and belief... exclusive" until 1998 and that others began using the term "in or around the year 1999." In addition, applicant explains that it "did not become

aware of these infringing activities" until after its prior registration for the term was cancelled and it "always was and still is Applicant's intention to assert its proprietary rights against these infringers as soon as re-registration of its mark takes place." Supplemental Brief, at 2.

In essence, applicant appears to have chosen not to assert against other parties any proprietary rights in the term INTERMEDIATE MESH that it may have acquired through use of the term, and its argument essentially acknowledges that use of the term by others has gone unchecked since 1999. We cannot, in the context of this proceeding, determine whether use by others of the term "Intermediate mesh" should be halted as infringing. Those parties are not before us and, moreover, the Board's jurisdiction extends only to determining the right to registration, not rights to use. We cannot, as applicant requests, discount evidence of adoption of "Intermediate mesh" by others to designate their mesh products for use in construction.

Accordingly, we affirm the examining attorney's refusal of registration on the ground that INTERMEDIATE MESH is generic.

Although we have concluded, on the record before us, that INTERMEDIATE MESH is generic, should this conclusion

be found in error in any appeal that may follow, we now consider whether applicant's proffered evidence of acquired distinctiveness is sufficient to support registration under Section 2(f).

Applicant submitted to the examining attorney a declaration by Barbara Catlow, applicant's Manager of Marketing Services. Ms. Catlow attests to more than 14 years of continuous use of INTERMEDIATE MESH; to annual sales between 1989 and 2002 ranging from a bit more than \$218,000 to over \$444,000; to display of applicant's "Dryvit wall system... including reinforcing meshes that form a part thereof, one of which was the mesh identified" by the applied for mark at three trade shows on an annual basis, and at four other trade shows "many" years; to distribution of approximately 20,000 pieces of promotional literature each year; and to expenditure of approximately \$33,000 a year since 1989 for trade shows and promotional literature. Attached to Ms. Catlow's declaration is "a collection of promotional literature published and distributed by applicant" during the 14 years prior to the declaration. Each of these is single-page sheet discussing applicant's various mesh products.

Each promotional sheet has a subsection entitled "uses" and in each of these sections, applicant lists its

available mesh products. On one of the inserts, "Corner Mesh," for example, is recommended for use, among other places, on outside corners; and the "Intermediate" (followed by the statutory registration symbol) product is explained to be "A 12-ounce mesh recommended for the second story and above where a medium amount of traffic is anticipated, i.e., walkways, balcony areas, etc."

INTERMEDIATE MESH is used by applicant in such a manner that it would be perceived as indicating a mesh product where traffic or opportunity for wear would be at a medium level. The INTERMEDIATE MESH is not suitable for high traffic areas (for which PANZER 20, a 20-ounce mesh, is recommended) and other meshes are touted for lower traffic areas (e.g., STANDARD, a 4.3 ounce mesh, is recommended "for all applications where no abuse from people, machines, window washing equipment, etc., is anticipated").

We agree with the examining attorney's conclusion that the evidence of acquired distinctiveness is insufficient to support registration of a term that, even based on applicant's own use, if it is not generic, would be perceived as highly descriptive. We have no context for the sales figures, we have no attendance figures for the trade shows, and we have no information about how INTERMEDIATE MESH may be promoted at the trade shows, apart

from being listed on the product promotional inserts. In addition, we have acknowledged uses by others of the term to indicate medium weight mesh products. We therefore affirm the examining attorney's refusal to accept the evidence of acquired distinctiveness offered under Section 2(f).

Decision: The examining attorney's refusal to register INTERMEDIATE MESH on the Principal Register under Section 2(f) is affirmed, both because the term is generic and, even if descriptive but not generic, has not been shown to have acquired distinctiveness.